REMARKS/ARGUMENTS

The Office Action mailed January 26, 2004 has been reviewed and carefully considered. Claims 4 is canceled. Claim 1 has been amended. Claim 1-3, 5-7, and 9-10 are pending in this application, with claim 1 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

In the Office Action mailed January 26, 2004, claims 1-6 and 9-10 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,971,180 (Kobayashi).

Claim 7 stand rejected under 35 U.S.C. §103 as unpatentable over Kobayashi.

Before discussing the cited prior art and the Examiner's rejections of the claims in view of that art, a brief summary of the present invention is appropriate. The present invention relates to a vibration damper having a piston-cylinder unit with a damping valve 3 with a variable damping force arranged in the piston. The piston divides the cylinder into two work spaces 7, 8. The piston also includes further non-return valves 1 and 2 in series with the damping valve 3. Non-return valve 1 allows flow therethrough and provides a damping force in the compression stage of the vibration damper and non-return valve 2 allows flow therethrough and provides a damping force in the rebound or extension stage of the vibration damper. The non-return valves 1, 2 generate a soft damping characteristic of the vibration damper in the compression and rebound stage, respectively. The damping valve 3 is adjustable to offset the soft characteristics (see page 4, lines 8-16 and page 10, lines 1-8 of the application). That is, when the damping valve 3 is not actuated, the soft characteristics of the vibration damper are exhibited. Furthermore, the damping valve 3 is arranged in the piston such that the flow of damping medium through the damping valve 3 is in a first direction in the rebound stage and in a second opposing direction in the compression stage. To

exchange fluid between the two work spaces on opposing sides of the piston, a flow of damping medium must flow through the damping valve 3. There is no other path between the two work spaces. Finally, the damping valve is operatively arranged to that it is set to a precontrolled damping force setting in one of the rebound and compression directions and controllable via an actuator in the other of the rebound and compression directions (page 10, lines 9-11).

Independent claim 1 recites that the "damping valve in series with said first and second non-return valve comprises a sole passage for said damping medium through said piston and between said two working spaces such that said damping medium is required to flow through said flow path of said damping valve in a first direction when damping medium is exchanged between said two working spaces in the rebound direction and said damping medium is required to flow through said flow path of said damping valve in a second direction when damping medium is exchanged between said two working spaces in the compression direction of the vibration damper".

Kobayashi discloses a valve 94 in the piston of a shock absorber that is either open or closed. Figs. 2 and 3 of Kobayashi disclose that even if the damping valve 94 of Kobayashi is closed, i.e., there is no flow through the piston of Kobayashi, the damping medium can still be exchanged between the two work spaces by valves 64 and 52 in the rebound direction (see Fig. 2 of Kobayashi) and valves 62 and 54 in the compression direction (see Fig. 3 of Kobayashi) by a path surrounding the cylinder. Accordingly Kobayashi fails to teach that the damping medium is required to flow through the damping valve when damping fluid is exchanged between the two work spaces, as expressly recited in independent claim 1.

Independent claim 1 further recites that the damping valve is operatively arranged for providing a precontrolled damping force setting in at least one of the rebound direction and the compression direction. This is not the case in Kobayashi because the damping valve 94 can either

be open or closed in each of the rebound and compression directions. Accordingly, Kobayashi fails to disclose that the damping valve is operatively arranged for providing a precontrolled damping force setting in at least one of the rebound direction and the compression direction, as expressly recited in independent claim 1.

For all of the above reasons, it is respectfully submitted that independent claim 1 is not anticipated by Kobayashi under 35 U.S.C. §102.

Since Kobayashi specifically discloses valves which allow the exchange of damping fluid even when there is no flow through the piston, it is respectfully submitted that independent claim 1 is also allowable over Kobayashi.

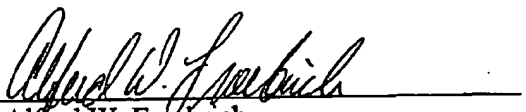
Dependent claims 2-3, 5-7, and 9-10, being dependent on independent claim 1, are deemed allowable for the same reasons expressed above with respect to independent claim 1.

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 

Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: April 23, 2004